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Paper No. 6

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APR 08 2002

In re Application of :
Eric Victor Siegel et al :
Application No. 09/808,911 : ON PETITION
Filed: March 14, 2001 :
Attorney Docket No. KAQ-002 :

This is in response to the petition under 37 CFR 1.47(a), filed January 30, 2002.

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 CFR 1.136(a).

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks item (1) set forth above.

As to item (1), petitioner has not demonstrated with documented evidence that inventor Eric Victor Siegel refuses to join in the application after having been presented with the application papers (specification, claims, drawings and declaration). In this regard, Kevin J. Canning, attorney of record, states in the present petition that "a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to Eric Victor Siegel and

Alexander Day Chaffee for signature." However, in his Statement of Facts and in the letter to Mr. Siegel, it appears that only the declaration was presented to inventor Siegel. Therefore, based on the evidence submitted, it is unclear whether inventor Siegel was presented with a complete copy of the application papers for his review prior to any subsequent refusal.¹ If joint inventor Siegel was not presented with a copy of the application papers, then Mr. Siegel could not attest that he has "reviewed and understands the application papers." Did Mr. Siegel receive the application papers? See MPEP 409.03(d). Unless petitioner can show that a copy of the application papers was presented to Mr. Siegel, then petitioner will have to mail a copy of the complete application papers to Mr. Siegel's last known address, return receipt requested. A cover letter of instructions should accompany the mailing of the application papers setting a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. The proof of the pertinent events should be made by a statement of someone with firsthand knowledge of the events and should include documentary evidence, such as certified mail return receipt, cover letter of instructions, telegraphs, etc. See MPEP 409.03(d).

Where there is an express or oral refusal, that fact, along with the time and place of the refusal, must be stated in an affidavit or declaration by the party to whom the refusal was made. Where there is a written refusal, a copy of the document(s) evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the rule 47 applicant that an omitted inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence must be submitted.

¹ The evidence is sufficient to establish that a copy of the application papers was presented to Alexander Day Chaffee, the other nonsigning inventor, in view of the reference thereto in the letter dated September 12, 2001 to Mr. Chaffee, and that Mr. Chaffee has not responded by the September 23, 2001 deadline set forth therein.

Whenever an omitted inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In order to expedite reconsideration of the petition under 37 CFR 1.47(a), petitioner should submit the petition by facsimile transmission to the number indicated below and to the attention of Wan Laymon.

Further correspondence with respect to this matter should be addressed as follows:

By mail: U.S. Patent and Trademark Office
Mail Stop DAC
P.O. Box 2327
Arlington, VA 22202

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to Wan Laymon at (703) 306-5685.



Frances Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy